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10/774,672

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Ke-Chi Jang

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EXAMINER

PEACHES, RANDY

ART UNIT

PAPER NUMBER

2617

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DELIVERY MODE

02/20/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/774,672

Applicant(s)

JANG ET AL.

Examiner

Randy Peaches

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 November 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 8-13, 29 and 31-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-13, 29 and 31-35 is/are rejected.
- 7) ☒ Claim(s) 34-39 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |                                                                                                             |                                                                                         |
|-------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                            | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____                                                |

## DETAILED ACTION

### *Response to Arguments*

Applicant's arguments with respect to **claims 8-13, 29, and 31-39** have been considered but are moot in view of the new ground(s) of rejection.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. **Claims 8-13, 29, and 31-35** are rejected under 35 U.S.C. 103(a) as being unpatentable over Havinis et al. (U.S. Patent Number 6,311,069 B1) in view of Zellner et al. (U.S. Patent Number 6,675,017 B1).

Regarding **claim 8**, Havinis et al. discloses a telecommunication system, which reads on claimed "wireless communication system," comprising:

- a station having communication logic, which reads on claimed "software," for: receiving a capability request, wherein capability request is interpreted as information regarding location or position information of a mobile station (MS, 20). See column 3 lines 56-62 and column 4 lines 26-30; and

- generating and transmitting a capability request response that includes a status indicator of a non-emergency-services position-determination (NESPDP) capability, wherein the NESPDP capability is user-selectable. See column 6 lines 4-22 and lines 42-50.
- wherein the capability request response includes, whether a subscriber of the said mobile station will accept or reject the positioning request, which reads on claim "status indicator", of a non-emergency services position determination capability of the station. See column 6 lines 4-12;

However, Havinis et al. fails to clearly disclose whether the user selection allows the user to enable or disable all requests irrespective of the provider associated with the request.

Zellner et al. discloses in column 3 lines 59-65, wherein the user can block location information, which reads on claimed "NESPDP," for individual transmission, for specific transmissions or for all transmissions.

Therefore, at the time of the invention it would have been obvious to a person of ordinary skilled in the art to modify the teachings of Havinis et al. (U.S. Patent Number 6,311,069 B1) to include Zellner et al. (U.S. Patent Number 6,675,017 B1) in order to provide the user the flexibility disable or enable the transmission of position information totally to providers, regardless of the type of request.

Regarding **claim 9**, as the combination of Havinis et al. and Zellner et al. are made, the combination according to **claim 8**, Havinis et al. continues to disclose wherein the

capability request response further includes at least one of a GPS acquisition capability indicator and a position calculation capability indicator. See column 2 lines 28-41.

Regarding **claim 10**, as the combination of Havinis et al. and Zellner et al. are made, the combination according to **claim 8**, Havinis et al. continues to disclose wherein the station is a first said MS (20) and the communication logic is first receiving logic (24), the said telecommunication system further comprising a second station, MSC (14) having second communication logic (13) for generating and transmitting the capability request. See column 5 lines 27-29.

Regarding **claim 11**, as the combination of Havinis et al. and Zellner et al. are made, the combination according to **claim 10**, Havinis et al. continues to disclose wherein the said MSC (14) comprises positioning logic, which reads on claimed "position determining element." See column 6 lines 31-37.

Regarding **claim 12**, as the combination of Havinis et al. and Zellner et al. are made, the combination according to **claim 8**, Havinis et al. continues to disclose wherein the station is a said MS (20). See column 4 lines 49-53.

Regarding **claim 13**, as the combination of Havinis et al. and Zellner et al. are made, the combination according to **claim 8**, Havinis et al. continues to disclose wherein the said station is selected from the group consisting of: a cellular phone, a wireless

enabled personal digital assistant, a wireless-enabled personal computer, a GPS device, and a pager. Havinis et al. discloses a cellular phone. See column 1 lines 39-43.

Regarding **claims 29**, Havinis et al. discloses a method of operating an element of a wireless communication network, comprising:

- transmitting a non-emergency services position determination message to a mobile station. See column 5 lines 27-36;
- receiving whether a subscriber of the said mobile station will accept or reject the positioning request, which reads on claim "status indicator," indicating a non-emergency services position determination capability of the station. See column 6 lines 4-22 and lines 42-50; and
- preventing a plurality of NESPD messages from being transmitted to the said MS in response to receiving the status indicator. See column 6 lines 23-31.

However, Havinis et al. fails to clearly disclose whether the user selection allows the user to enable or disable all requests irrespective of the provider associated with the request.

Zellner et al. discloses in column 3 lines 59-65, wherein the user can block location information, which reads on claimed "NESPD," for individual transmission, for specific transmissions or for all transmissions.

Therefore, at the time of the invention it would have been obvious to a person of ordinary skilled in the art to modify the teachings of Havinis et al. (U.S. Patent Number

6,311,069 B1) to include Zellner et al. (U.S. Patent Number 6,675,017 B1) in order to provide the user the flexibility disable or enable the transmission of position information totally to providers, regardless of the type of request.

Regarding **claim 31**, as the combination of Havinis et al. and Zellner et al. are made, the combination according to **claim 29**, Havinis et al. discloses a message from a said NESPD regarding the service that is dependent on the said MS's position within the said network. See column 6 lines 31-38.

Regarding **claim 32**, as the combination of Havinis et al. and Zellner et al. are made, the combination according to **claim 29**, Havinis et al. continues to disclose wherein the said status indicator indicates whether the mobile station is configured to:

- refrain from providing information for all non-emergency services. column 6 lines 4-22 and lines 42-50;
- provide position information for all non-emergency services. See column 2 lines 28-41.

Regarding **claim 33**, as the combination of Havinis et al. and Zellner et al. are made, the combination according to **claim 29**, Havinis et al. continues to disclose wherein the status indicator indicates whether the mobile station is configured to provide or refrain from providing position information for NESPD in a manner independent of any particular NESPD. See column 6 lines 4-22 and lines 42-50.

Regarding **claim 34**, as the combination of Havinis et al. and Zellner et al. are made, the combination according to **claim 29**, Havinis et al. continues to disclose wherein the element is a Service Mobile Location Center (SMLC), which reads on claimed "position determining entity." See column 2 lines 25-28.

Regarding **claim 35**, as the combination of Havinis et al. and Zellner et al. are made, the combination according to **claim 29**, Havinis et al. continues to disclose wherein the status indicator is included in a message further containing native capability data of the said MS. See column 5 lines 32-37.

#### ***Allowable Subject Matter***

**Claim 36-39** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Randy Peaches whose telephone number is (571) 272-7914. The examiner can normally be reached on Monday - Friday.



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H. Feild can be reached on (571) 272-4090. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Randy Peaches

RP

  
**JOSEPH FEILD**  
**SUPERVISORY PATENT EXAMINER**